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OFFICE OF PETITIONS

In re Application of :
Robert H. Shelton :
Application No. 09/025,279 : DECISION ON PETITION
Filed: 18 February, 1998 :
Atty Docket No. 050128-1010 :
:

This is a decision on the renewed petition under 37 CFR 1.183, filed on 14 December, 2005, requesting waiver of the rules, for a corrected filing date, which is also treated as a renewed petition under 37 CFR 1.10(d), requesting that the above-identified application be accorded a filing date of 17 February, 1998, rather than the presently accorded filing date of 18 February, 1998. This is also a decision on the concurrently-filed petition for expedited treatment under 37 CFR 1.182.

The petition for expedited treatment is **GRANTED**.

The petition under 37 CFR 1.183 and 1.10(d) is **DENIED**.¹

BACKGROUND

On 18 February, 1998, the application was filed.

On 16 June, 1998, a petition under 37 CFR 1.10(d) was filed, requesting that the application be accorded a filing date of 17 February, 1998, rather than the currently-accorded filing date of 18 February, 1998.

On 31 May, 2000, the petition was dismissed.

On 1 June, 2005, a Notice of Allowance and Fee(s) Due was mailed, requiring payment of the issue fee.

¹ This is a final agency action. See MPEP 1002.02.

On 1 August, 2005, the issue fee was submitted, along with corrected drawings, a power of attorney, and a petition under 37 CFR 1.183.

On 18 November, 2005, the petition was dismissed as untimely.

On 14 December, 2005, the present request for reconsideration was filed, along with a petition for expedited treatment. Petitioner requests waiver of the timeliness requirement such that the petition filed on 1 August, 2005, may be considered on its merits. Specifically, petitioner states that when then-counsel of record, John Sigalos, received the decision mailed on 31 May, 2000, "he was in a diminished mental state due to the fact that his daughter had recently died in April, 2000. While in this depleted mental state, he placed the decision in a file and forgot about it." Petitioner further asserts that applicant's second patent attorney, Andrew Hassell, was engaged shortly thereafter, but was informed by Mr. Sigalos that he (Sigalos) would attend to [the matter of the petition].

Petitioner further states, in pertinent part:

The application was dormant for a long period of time while the claims were being appealed. It was therefore only in June, 2005, after the Applicant prevailed on such appeal of all claims and consequently reviewed the file, that Applicant and his patent attorneys became aware of the fact that a Request for Reconsideration of the May 31, 2000 Decision had not been filed with the USPTO.

STATUTES AND REGULATIONS

35 U.S.C. 21(a) states:

The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered to be filed in the Office on the date on which it was deposited with the United States Postal Service but for postal interruptions or emergencies designated by the Commissioner.

37 C.F.R. § 1.10 *Filing of correspondence by "Express Mail."*

(a) ...

(b) ...

(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

(d) ...

...

37 C.F.R. § 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

OPINION

Applicant was given reasonable notice as to the necessity to timely file a response to the decision mailed on 31 May, 2000. Petitioner's failure to timely and adequately respond to the

aforementioned petition decision was unfortunate, but the failure to timely file a renewed petition or other reply in response to the petition decision mailed on 31 May, 2000, was not due to a circumstance beyond the control of petitioner in the exercise of reasonable care and diligence.² As such, there is no adequate showing of "an extraordinary situation" in which "justice requires" suspension of the rules.³ Even assuming, *arguendo*, that clerical inadvertence or mistake led to petitioner's failure to submit a proper reply, such is not a grounds for requesting waiver of the regulations.⁴

While the Office is mindful of Mr. Sigalos' "diminished mental state," the showing of record is that the delay resulted from a lack of ordinary care and diligence in that the May, 2000, decision was apparently misfiled. Additionally, the showing of record is that petitioners were preoccupied with other matters, i.e., the appeal, and the extraordinarily long period of delay was a result of said preoccupation. Preoccupation with other matters indicates a lack of diligence and due care which does not merit waiver of the rules.

Circumstances resulting from petitioners' failure to exercise due care, or lack of knowledge of, or failure to properly apply, the Patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief.⁵

With regard to petitioner's contention, in the present renewed petition, that the "[a]pplicant is the real victim in this case and the USPTO has the discretion to provide an adequate remedy," the U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of petitioner, and petitioner is bound by the consequences of those actions or inactions.⁶ Here, the problem

² See Brenner v. Ebbert, 398 F.2d 762, 765, 157 USPQ 609, 611 (D.C. Cir. 1968), *cert. den.*, 159 USPQ 799 (The Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received).

³ See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers).

⁴ See In re Kabushiki Kaisha Hitachi Seisakusho 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994) (clerical error causing delay leading to a loss of right does not warrant suspension of the rules).

⁵ See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

⁶ Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987).

at issue could also have been avoided by the exercise of ordinary care and diligence. Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence.⁷

The untimeliness of the petition notwithstanding, in the interest of providing full consideration of all issues, the petition of 1 August, 2005, will, nevertheless, herein be treated on its merits.

In the petition filed on 1 August, 2005, petitioner requests waiver of the rules under 37 CFR 1.183 for reconsideration of the prior decision dismissing the petition under 37 CFR 1.10. Petitioner avers that the attorney who filed the petition, John L. Sigalos, failed to timely file a response to the decision on petition mailed on 31 May, 2000, because of mental incapacity due to the untimely death of his daughter, and Mr. Sigalos' appointment as executor of her estate. In support of petitioner's contention that the application was deposited in Express Mail on 17 February, 1998, petitioners have provided, *inter alia*, a declaration dated 27 July, 2005, by registered patent attorney John L. Sigalos, stating, *inter alia*, that:

15. I personally deposited the application packet in the Express Mail collection box, located on the property of my office building at Carrillon Towers, 13601 Preston Road, Suite 402W, Dallas, Texas 75240, before the last pick up time of 5:00 p.m. on February 17, 1998.

Petitioner claims that the application was deposited with the United States Postal Service (hereinafter "USPS") on 17 February, 1998, pursuant to the requirements of 37 CFR 1.10. Petitioner acknowledges that the date of deposit in Express Mail shown on petitioner's Express Mail receipt is 18 February, 1998, but argues that the application was actually deposited in an Express Mail drop box on 17 February, 1998, before the last scheduled pickup of the day.

The petition filed on 16 June, 1998, is accompanied by a statement by a USPS employee which states:

Our investigation reveals that although your Express Mail article was deposited on the 17th, it was not scanned into our system until February 18th, 1998, when it was processed at the Airport Mail Center in

⁷ U.S. v. Lockheed Petroleum Services 709 F.2d 1472, 1475 (Fed. Cir. 1983).

Dallas. When a mailpiece is placed in a collection box, due to time constraints of meeting collection schedules, the Express Mail may not be scanned in at your post Office.

A grantable petition under 37 CFR 1.10(d) must include "a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in 'Express Mail Post Office to Addressee' service prior to the last scheduled pickup for that day." In addition, the showing "must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the 'Express Mail Post Office to Addressee' service of the USPS." Evidence from the USPS may be, for example, the Express Mail Corporate Account Mailing Statement or a statement by an appropriate official of the USPS that, according to a USPS record, the "date-in" on petitioner's Express Mail receipt is erroneous and is accompanied by a copy of the relevant USPS record. Evidence that came into being within one day after the deposit of the correspondence as Express Mail may be, for example, a log book which contains information, such as the Express Mail label number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit, the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of the log book entry.

The statement from the USPS employee only corroborates the fact that the Express Mail package was deposited on 17 February, 1998. The statement does not corroborate the time of the last scheduled pick up from the Express Mail drop box where the package was deposited nor that the package was deposited in that particular Express Mail drop box prior to the last scheduled pick up. Further, the statement is not accompanied by a copy of the relevant USPS record which evidences that the "date-in" on the Express Mail label is erroneous.

Moreover, the present renewed petition is not supported by persuasive evidence. Moreover, the affidavit of attorney Sigalos was made over seven (7) years after the asserted date of deposit and recites personal remembrances of the preparation and filing of these papers with the USPTO, including that the application was filed prior to the last Express Mail pick-up of the day. The papers are not unusual, and it is not understood why the filing of this particular application would stand out in such detail in the affiant's memory, particularly in view of the fact that affiant prepared and mailed similar papers on a routine basis.

Additionally, petitioners have not established the time of the last scheduled pickup on 17 February, 1998. As stated in the declaration of Randy R. Schoen, Mr. Schoen contacted the USPS on 12 July, 2005, and was informed that Express Mail delivery information, including collection records, for 1998, was no longer available from the USPS. As such, assuming, *arguendo*, the Express Mail package containing the application was deposited prior to 5:00 p.m. on 17 February, 1998, the time of the last pickup on that date cannot be verified.

Likewise, the declaration of registered patent attorney Leslie C. Cook, stating that she regularly used the Carrillon Towers Express Mail box in 1997, and that she knew that the last pickup time was 5:00 p.m. is unhelpful because (a) she is not a USPS employee, (b) she made the declaration eight (8) years after 1997, and (c) the time period during which she assert she used the Express Mail box was 1997, not 1998.

As such, petitioner has clearly not met the requirements set forth in 37 CFR 1.10(d) for proof that the application was deposited prior to the last pickup of the day on 17 February, 1998, and, as such, the petition must be dismissed.

With regard to the petition under 37 CFR 1.183, the Commissioner may waive requirements of the rules so long as those requirements are not requirements of the statute.⁸

Under 35 U.S.C. § 111, the filing date of an application is defined as the date the specification and drawings are filed in the U.S. Patent and Trademark Office. Under 35 U.S.C. § 21, the Commissioner may by rule prescribe that any paper or fee required to be filed in the U.S. Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Commissioner.

Since there were no postal service interruptions or emergencies designated by the Commissioner on 17 February, 1998, the only basis under the statute for according this application a filing date of 17 February, 1998, would be a showing that the

⁸ In re Kruysman, Inc., 199 USPQ 110 (Comm'r Pats. 1977).

application was deposited with the United States Postal Service on 17 February, 1998.

However, the evidence supplied by the applicants indicates that the application was not deposited with the United States Postal Service on 17 February, 1998. As indicated above, a requirement of the statute cannot be waived by the Commissioner.

CONCLUSION

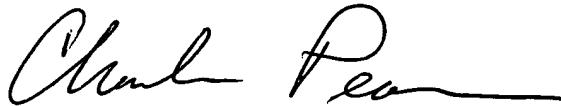
The evidence and arguments present have been carefully considered, but are not persuasive of applicant's entitlement to a filing date of 17 February, 1998. Applicant must establish to the satisfaction of the Commissioner that the original application papers were properly deposited in Express Mail service on 17 February, 1998. In this case, applicant has not provided sufficient evidence to support his entitlement to a filing date of 17 February, 1998. Accordingly, applicant has failed to meet his burden.

The petition is granted insofar as the request for reconsideration has been favorably considered. The petition to accord a filing date of 17 February, 1998, is denied.

Accordingly, the application will be processed with the presently-accorded filing date of 18 February, 1998.

The application is being forwarded to the Publishing Division for processing into a patent.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.



Charles A. Pearson
Director, Office of Petitions